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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,029	10/07/1999	TETSUYA OUCHI	JAO-38350RE	2719

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EXAMINER

ROGERS, SCOTT A

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,029

Applicant(s)

OUCHI, TETSUYA

Examiner

Scott A. Rogers

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/653,312.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckman et al (WO 93/16542) in view of Morita et al (US 5014297).

Referring to claims 14-16:

Druckman et al disclose a communication device comprising: a reception determination means 30 for determining whether the communication device is in one of a reception possible condition and a reception impossible condition; and a reception process means 36 for performing reception of an incoming call when the reception determination means determines that the communication device is in the reception possible condition, and for performing reception of the incoming call, regardless of whether the communication device is in the reception impossible condition. See abstract, page 2, lines 17-23, page 9, lines 22-31, and page 10, lines 9-16.

While Druckman et al do not specifically address the communication device having to be in a specific mode, such as an answering machine mode, for performing reception of the incoming call, regardless of whether the communication device is in the reception impossible condition, such operation is obvious in view of the prior art.

Similarly, while Druckman et al do not specifically address the communication device not performing reception of the incoming call when the reception determination means determines that the communication device is in a reception impossible condition and the communication device is not in a specific mode, such as an answering machine mode, such operation is obvious in view of the prior art.

Morita et al disclose the idea of setting an automatic answer mode whereby an incoming call is received. Inherently, when the automatic answer mode is not set, incoming calls are not received. See at least the abstract and background.

It would have been obvious to one of ordinary skill in the art to have modified Druckman et al in view of Morita et al to have provided such an automatic answering machine mode, whereby when the mode is set, reception of incoming calls is performed when the reception determination means determines that the communication device is in a reception impossible condition. Inherently, when the automatic answering machine mode is not set, reception of incoming calls is not performed when the reception determination means determines that the communication device is in a reception impossible condition. Such a modification allows recording of incoming calls when the communication device is unattended or being used, thereby preventing the loss of messages and improving usefulness of the communication device.

Referring to claims 17-19:

These claims are directed to the method of operating a communication device and correspond directly to the function of the communication device set forth in claims 14-16 and are therefore rejected on the same grounds as claims 14-16.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Druckman et al and Morita et al as applied to claims 14-19 above, and further in view of well known prior art.

Referring to claims 20-22:

These claims are directed to a recording medium including a control program for controlling operation of a communication device corresponding directly to the function of the communication device set forth in claims 14-16. The function of the control program is rejected on the same grounds as claims 14-16.

While Druckman et al and Morita et al do not disclose a recording medium storing a control program, such programs are notoriously well known in the art.

It would have been obvious to one of ordinary skill in the art to have modified the Druckman et al and Morita et al combination in view of well known prior art to have provided a recording medium including a control program for controlling operation of the communication device in order to allow easy modification or upgrade of the program to change, adapt, and/or improve operation of the communication device.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 20-22 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 20-22, while defining a recording medium, do not define a "computer-readable medium" and is thus non-statutory for that reasons. A recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory. For example, the preamble of claim 20 could read: "A computer readable recording medium storing a control program, for controlling operation of a communication device, that:".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "performing reception of the incoming call, regardless of whether the communication device is in the reception impossible condition" or "[controlling] the communication device to receive the incoming call, regardless of whether the communication device is in a reception impossible condition". If the communication device is in the reception impossible condition, the ability to perform

reception of the incoming call or control the communication device to receive the incoming call is indefinite. How the device has the ability to perform this function must be clearly set forth in the claims. Merely having a mode is not sufficient.

Reissue Applications

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

It is not sufficient for an oath /declaration to merely state that application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure. Rather, the oath /declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the amended or new claims. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

All that is needed for the oath /declaration statement as to error is the identification of "at least one error" relied upon. In identifying the error, it is sufficient that the reissue oath /declaration identify a single word, phrase, or expression in the specification or in an original claim, and explain how it renders the original patent wholly or partly inoperative or invalid.

Item 7 in applicant's reissue declaration merely states that the original claims do not provide adequate scope of protection for what amounts to a reproduce the new

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claims. This does not identify a specific error and explain how it renders the original patent wholly or partly inoperative or invalid.

Claim Rejections - 35 USC § 251

Claims 1-22 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Cited Art

The art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 2-134967 discloses a terminal with telephone and facsimile functions for ISDN which stores message from a remote party if the telephone line is busy.

JP 5-268323 discloses an automatic answering telephone with a two line interface circuit that has the function to record a message from one line and send out a busy message to the other line when an incoming call is detected during message recording.

Theis (US 4800583) discloses an overflow call handling system whereby in the event all incoming lines are busy, the telephone network will automatically pass incoming calls to answering machines.

Baum et al (US 5159626) discloses an answering machine coupled to a multi-line switching system coupled to a plurality of incoming telephone lines (see col. 4, line 4 to col. 5, line 20 for relevant disclosure).

Mizutani et al (US 6195170 B1) teach a data retaining unit that, if the effectiveness determination unit determines that the present state is not the state where an effective determination by the print-failure determining unit is possible, retains the data stored in the reception memory even after the data has been printed out regardless of the result of the determination by the print-failure determining unit.

Nishii et al (US 6088128 A) teach a standby state in which the main power supply is turned on for an incoming call for facsimile communication, while the main power supply is not turned on for an incoming call for speech communication.

Hwang (US 5923748 A) teaches identifying if a receiver off hook from a telephone switch during an off-hook state and if a receiver is off hook, informing the user. However, if the user disregards the receiver off hook tone, the telephone is automatically switched from the off-hook state to an on-hook state after a predetermined period of time, even though the handset remains off-hook. The telephone will still ring in response to receiving an incoming telephone call. At this point, the user can answer the incoming call by hanging up the handset and then picking it up once more.

Yoshida et al (US 5619344 A) teach that when a multi-output recording is not permitted for failure to meet described conditions above, regardless of whether a communication bound for multi-output recording has been selected, the received picture data is received in a memory circuit and an indication is made so as to indicate that the received data has been stored, instead of execution of the output printing.

Vandling (US 4055729 A) teaches, in addition to a transfer function, a coupler circuit 24 that provides an exclusion function to automatically break the primary communications path with the facsimile transceiver 10 when the handpiece 48 of the telephone set 34 is placed on-hook even if the cover 42 is closed. This assures that a telephone line will not accidentally be left off-hook at the conclusion of a facsimile transmission even though the handpiece 48 of the telephone set 34 has been placed on-hook. In addition, the exclusion function resets the coupler circuit 24 so as to prepare the telephone set 34 to receive the next incoming call regardless of the on or off condition of the facsimile transceiver.

Takahashi (JP 05292277 A) teaches when a call is incoming, the reception side equipment is changed into a reception mode regardless of whether there is any reception disable reason or not and checks the state of the system to determine whether the reception is enabled or not. When recording paper sheets are exhausted and a SAF memory 9 to perform reception in place of the paper recording device is full, as determined by the system check, a reception disable information return mode is set, and information showing such a state is returned to the facsimile equipment at the transmission source.

Tsushima (US 5063589) discloses an automatic telephone answering machine for switching from a "stop" mode to an "automatic answer" mode. The mode switching arrangement causes the machine to switch to the "automatic answer" mode and then answer the call during the same phone call.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Rogers whose telephone number is 571-272-7467. The examiner can normally be reached Monday through Friday 6:00am-2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 571-272-7471.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service at 571-272-2600. Official correspondence by facsimile should be sent to 571-273-8300. The USPTO contact Center phone numbers are 800-PTO-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14 October 2005


SCOTT ROGERS
PRIMARY EXAMINER